



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,767	06/18/2001	Hyun-Jun Lee	P56408	8238

7590 03/31/2004
Robert E. Bushnell
Suite 300
1522 K Street, N.W.
Washington, DC 20005

EXAMINER

CHEN, ALAN S

ART UNIT	PAPER NUMBER
----------	--------------

2182

DATE MAILED: 03/31/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/881,767

Applicant(s)

LEE, HYUN-JUN

Examiner

Alan S Chen

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-24 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 9, 12, 13, 15, 18-21, 25 and 27 is/are rejected.
- 7) ☒ Claim(s) 4, 6-8, 10, 11, 14, 16, 17 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED FINAL ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 19-21, 25 and 27 rejected under 35 U.S.C. 102(b) as being anticipated by

Outlook.

As per claim 19, Outlook discloses a method comprising the steps of: converting received data corresponding to each letter received from a server (Incoming POP server for example, page 177) being specified into image and character data (displayed in the message viewer window as text and image), each letter transferred by electronic mail to the server from a plurality of users (account name and username on the server is required, page 177), the server having a unique address on a network (as indicated by the address on page 177 for incoming or outgoing mail) and performing a mail service function and sorting and storing image and character data by an account of the user; continuously determining whether an authorized user requests to view letters addressed to the authorized user (when the user double clicks, the response from the continual monitoring of events of the mouse and keyboard will cause the message to be displayed for the user); displaying information extracted from the stored image and character data when the authorized user requests to view said letters addressed to the authorized user (opens up the letter to full view when the user selects the message to view); determining information selected by the authorized user from the displayed information; reading image and character data corresponding

Art Unit: 2182

to the selected information among the stored image and character data (if the user has multiple messages, user selects the message he wants to view and it opens to full view); and printing the letters corresponding to the image and character data read by said step of reading image and character data (this step is an additional step that the user can take, upon opening the email, he/she can go to File->Print in the main menu to print. Note this is completely within the scope of the claims, whereupon the printing can be considered an additional step after reading image and character data Outlook).

As per claim 20, Outlook discloses claim 19 further comprising the step of printing a letter corresponding to the data read in said step of reading image and character data when the authorized user requests to print a letter (page 121).

As per claim 21, Outlook discloses claim 19 where step of sorting and storing the image and character data by the account of user being stored in a personal computer. This is inherent with Outlook, being a software application residing on a PC.

As per claim 25, Outlook discloses claim 19, said steps being implemented by a program stored in memory (Outlook is a software program stored on a hard drive).

As per claim 27, Outlook discloses claim 19, further comprising the step of viewing the letters and printing a letter corresponding to the data read in said step of reading image and character when the authorized user request to print a letter (the preview option indicated on page 121, allows one to view what is to be printed).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2182

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2,3,5,9,12,13,15 and 18 are rejected under 35 USC 103(a) as being unpatentable over No. 5,521,719 to Yamada in view of Outlook.

In reference to claims 1, 2 and 18, Yamada discloses an electronic letter receiver (Fig. 9, element 122 for receiving email), where letter came from a mail server (for the case of the email receiver, Fig. 9, element 122, the mail server is Fig. 10, element 138). Yamada further discloses the letter receiver being attached to a LAN (Fig. 10) wherein a personal computer (Fig. 10, element 135) is attached to the LAN as well as a printer (Fig. 10, element 135 and 140). The printer can automatically print email based on user's settings (Column 4, lines 15-28).

Yamada does not expressly disclose a letter storing unit, display unit, a user interface or a controller as specified in the limitations.

Outlook discloses an application that resides on a personal computer, causing the personal computer to be a letter storing unit accommodating sorting and storing of image and character data by the account of user (when user logs with username and password, messages addressed to him are downloaded to his PC), a display unit (the monitor of the PC) for displaying information extracted from the image and character data; a user interface unit (the Outlook graphic user interface application) outputting a display request signal when an authorized user requests to view a letter addressed to him (display request signal generated by PC upon double clicking, or single click depending on user preferences, on the message in Outlook) and outputting an account control signal (signal causes the retrieval of the message from the mail server in order to be displayed). Outlook discloses the Outlook application being a controller

Art Unit: 2182

that outputs email messages to the monitor based on the account user and allows for printing capabilities (page 121, hence generating a print control signal). Outlook teaches that mail servers have a unique address on a network, where the unique mail address is needed (pages 175-178, defining where the incoming, POP3 and outgoing, SMTP servers are) to communicate with the mail server.

Yamada and Outlook are analogous art because they are from similar problem solving area in the receipt, control and processing of email, one being more on a hardware level while the other on a software level.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Yamada with Outlook to have an application resident on a personal computer that handles email.

The suggestion/motivation for doing so would have been the need to have a software application to compliment an email hardware system, in order to control and display sending and receipt of email on a Windows operating system which is the dominant operating system for personal computers.

Therefore, it would have been obvious to combine Yamada with Outlook for the benefit of a software application resident on a personal computer for an email system.

In reference to claim 2, Yamada and Outlook discloses claim 1. Outlook further discloses that the letter storing unit (would be the hard drive of the PC) is included within a personal computer, being software resident in the PC.

In reference to claim 3, Yamada and Outlook discloses claim 1. Outlook further disclose requiring a user to login with a username and password so the application can open and output a

Art Unit: 2182

display request signal for displaying a message on the monitor and account control signal for retrieving messages.

In reference to claim 5, Yamada and Outlook discloses claim 1. Outlook further discloses that the email application is stored on the hard drive of the computer. The email application is the system program that serves as the controller.

In reference to claim 9, Yamada and Outlook discloses claim 1. Outlook further discloses converting data corresponding to the letter under the control of the software where the data received is converted to different text fonts, sizes, and images based on fields/tags in the received data.

In reference to claim 12, Yamada and Outlook discloses claim 1. Outlook further discloses displaying information on the monitor from information extracted from the image and character data to the person who logged in the computer.

In reference to claim 13, Yamada and Outlook discloses claim 1. Outlook further discloses using the application requiring the use of keyboard and mouse that allows the user to input his username and password.

In reference to claim 15, Yamada and Outlook discloses claim 1. Yamada discloses a PC interfaced with the LAN where the software application serving as the controller physically resides or is connected to the computer, the software application also making the personal computer the letter storing unit.

Response to Arguments

1. Any rejection not addressed in this Office Action has been withdrawn.

Art Unit: 2182

2. Applicant's arguments received 02/23/2004 have been fully considered but they are not persuasive.

Rejections under 35 U.S.C. 102(b)

Claims 19, 20, 21, 25, 27 and 28

3. Applicant argues: "... the continuing monitoring of a mouse and keyboard input is not the same as continuously determining whether an authorized user requests to view letters addressed to the authorized user. The present invention is more particular in its instruction. As mentioned above, in a 102 rejection, the limitations must be exactly as arranged in the claim. This is especially the case since Outlook cannot always process a view of the letters, so entering a key or mouse will not always give a view of the letters. Outlook certainly does not continuously monitor for viewing if for example the user request to view the letters as in certain modes of Outlook cannot receive requests to view the letters."

To further elaborate on the rejection and being completely within the scope of the claim limitation of "continuously determining whether an authorized user requests to view letters addressed to the authorized user" of claim 19, it is clear that when an authorized user request to view letters, a trigger/event must be given to the machine/apparatus. Otherwise, there is no way the machine/apparatus will know what the user is thinking or desires to do. Outlook does this by continuously monitoring for this trigger/event by the user. Communication to a computer by the user is done via keyboard strokes or mouse clicks (or some form of advanced technology such as speech recognition). As shown in Outlook (pg. 114, mailed with this action), the user highlights/double clicks inside the Message Pane (as you can see, a particular email is highlighted) and subsequently, the message appears on the Preview Pane). Outlook continuously

Art Unit: 2182

determines whether the authorized user requests to view letters by displaying the letter that the user selects *whenever* the user desires. Furthermore, the steps as listed in the claims are arranged in the exact order accordingly, e.g., Outlook receives the letter from a server->Outlook continuously monitors what the authorized user wants to see-> display the letter that the authorized user wants to see in preview pane (after user selects)-> user selects/double clicks the letter he wants to see in full view (pg. 117, mailed with this action) ->user clicks on the print button (Fig. 3.55 on page 117 in the toolbar of the window and Fig. 3.59 on page 121)->outlook reads image and character data and translates into a print format and then prints the message.

4. Applicant further argues: "Outlook does not include printing the letters corresponding to the image and character data read by said step of reading image and character data. Concerning claim 28, the Examiner had mentioned that Outlook discloses the step of viewing the letters and printing a letter corresponding to the data read in said step of reading image and character when the authorized user request to print a letter (the preview option indicated on page 121, allows one to view what is to be printed). However, the claim is stating that the letters that are viewed are being printed which is different from the letters that are printed are viewable."

Outlook reads on the claim either way, e.g., the letters that are views are printed (see page 117, Fig. 3.55, here the letter is being viewed, then the letter is printed after one clicks on the printer icon) and the letters that are printed are indeed printable if one chooses to preview the letter (see page 121, Fig. 3.59, the preview button).

5. Applicant further argues: "Furthermore, looking at page 121 of the Outlook paper, the viewing of a printed matter is not even mentioned. It only shows the dialog box used for printing. Therefore, this does not disclose that the letters which are viewed are printed, it only gives an

Art Unit: 2182

option of printing messages if a user chooses, but then the user must click on each separate message in order to print which can end up being a cumbersome and long process. As claimed, the Outlook paper does not disclose printing letters corresponding to the image and character data that is read. In reference to claim 27, Outlook does not disclose the step of viewing and printing the letters that are read. Page 121 of the Outlook paper only discloses that a letter can be read. So if a user views a letter, then he can optionally print the letter. However, this does not disclose that the letters that "viewed" are then viewed and printed."

Although, the picture shows only a preview button, it is inherent and well known in the art and to all who use Microsoft products that the print preview button gives a detailed example of what one can expect if one prints out the letter on a printer. More importantly, though the printing is an option, Outlook clearly anticipates the claim language since it anticipated the user printing the letter by the mere existence of such an option, this option being performed after the "reading image and character data corresponding to the selected information among the stored image and character data" (e.g., viewing the letter). In fact, Outlook also anticipates the view that both printing and reading steps are combined. When the user selects to option to print, Outlook actually has to read the image and character data (e.g., second to last limitation) and translate it into a code format that the printer can understand AND THEN the printer prints the letter.

Rejections under 35 U.S.C. 103(a)

Claims 1, 2, 3, 5, 9, 12, 13, 15 and 18

6. Applicant argues "... Yamada deals with an "Improved Group 3 Facsimile" as mentioned clearly in the title of Yamada. The paper of Outlook does not describe a facsimile function and it

Art Unit: 2182

is well known that Outlook 2000 is not capable of handling facsimiles, but is for e-mails.

According to MPEP 706.020) there must be a reasonable expectation of success and using Outlook 2000 in Yamada would be a mistake for the manufacturer of Yamada. Therefore, a person of ordinary skill in the art would not be motivated to combine the Outlook 2000 software with Yamada's group 3 facsimile subaddress communication function."

It can be clearly seen that Yamada invention deals with electronic mail as shown in Fig. 9, element 122 and Fig. 10, element 138. Yamadas invention deals with handling both faxes and emails, both of which Outlook can handle. Yes, Outlook indeed can handle faxes (see pg 259-262 of Outlook, included in this action). Though the motivation is predominately for email use, Yamada clearly has the motivation for using Outlook to handle the multiple emails it receives on its LAN (Fig. 10, element 138) addressed to different users.

7. Applicant further argues: "The Examiner stated that Outlook discloses the Outlook application being a controller that outputs email. However, this logic is, respectfully, incorrect, Outlook the software cannot be controller as claimed in an apparatus claim. Outlook is not structurally a controller, it is not an apparatus unit. The Examiner stated that Outlook the software discloses a user interface unit (the Outlook graphic user interface application). However, the Outlook paper and the Outlook software is not disclosing a portion of an apparatus which is a user interface unit. A graphical interface of outlook cannot be used in rejecting user interface unit outputting a display requesting signal, as Outlook the software cannot by its graphical interface program output a display requesting signal. Respectfully, using Outlook would be an improper rejection of the apparatus claim 1."

Art Unit: 2182

Software requires hardware to run. Outlook, albeit a software package, is indeed a “controller”, by the dictionary definition of the word (“One that controls” –dictionary.com). According to the claim limitation, the controller needs just to exist within the apparatus, it is not required to be hardware or software. Take for instance, if one is claiming an apparatus to be a computer system and is claiming an operating system (the main controller) for the computer system, one would obviously not claim the operating system as a physical unit. Nowhere in the claim language is the controller limited to being a physical unit. Furthermore, nowhere does it claim that the controller is an apparatus unit or controller unit for the implication of the apparatus or controller being a hardware device. Furthermore, regarding signals and Outlook. Outlook fundamentally is a controller tells the hardware what to do. When one clicks on a message in Outlook, this tells the hardware to send a signal(s) to the monitor to display the message. This applies to print control signals, etc. This further applies to applicant arguments to claims 3, 5 and 9.

Allowable Subject Matter

- 8. Claims 22-24 and 26 allowed.
- 5. Claims 4,6-8,10,11,14,16,17 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

- 9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2182

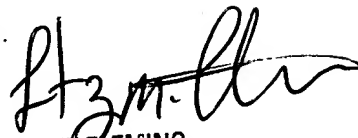
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S Chen whose telephone number is 703-605-0708. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC
03/25/2004


FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100